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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,683	08/07/2003	Raymond Catherall Atkins	604-690	1794

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EXAMINER	
AU, SCOTT D	
ART UNIT	**PAPER NUMBER**
2635	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,683	ATKINS ET AL.	
	Examiner	Art Unit	
	Scott Au	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This communication is in response to applicant's response to an Amendment, which is filed May 17, 2005.

An amendment to the claims 27-50 have been entered and made of record in the Application of Atkins et al. for an "Enhanced Identification System" filed August 7, 2003.

Claims 27-50 are pending.

Claims 1-26 are cancelled.

The new claims 27-50 introduced.

Response to Arguments

Applicant's amendments and argument to the double patenting rejection of the claims are insufficient to distinguish the claimed invention from the cited prior arts. Applicant's amendment and argument with respected to the pending claims 27-50, filed on May 17, 2005, have been fully considered but they are not persuasive for at least the following reasons.

On page 12, second paragraph, Applicant's argument that the new claims is distinguish over U.S. Patent 6,661,336 for double patenting rejection, is not persuasive.

See below for double patenting rejection for obvious.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27-50 are rejected under the judicially created doctrine of double patenting over claims 1-3,5-9,11-15, and 17-21 and 23-24 of U. S. Patent No. 6,661,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instants claims are generally broader than the claims in your U.S. Patent No. 6,661,336. See In re Van Ornum and Stang, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); In re Vogel, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "port").

Referring to claim 27 of (Application No. 10,635,683), the corresponding to (US# 6,661,336) claim 1, discloses an identification system comprising a reader including a transmitter for transmitting a signal; and

a plurality of transponders, each transponder including a receiver for receiving the reader signal and a transmitter for generating a transponder signal,

whereby upon recognising a transponder signal from a said transponder the reader immediately issues a mute instruction, muting all other active transponders and passing control to the said transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency. It is obvious the modulation of the reader signal includes at a pre-selected frequency in order to mute the transponders. However, (US# 6,661,336) claim 1 did not explicitly disclose the rf continuous wave reader signal at a pre-selected frequency. It is obvious implemented on a backscatter type as an alternative of transmitting the rf continuous wave reader signal at a pre-selected frequency. Furthermore, (US# 6,661,336) discloses the reader issues an acceptance instruction after the controlling transponder signal has been successfully received by the reader, the acceptance instruction being a modification of the reader signal, wherein the modification of the reader signal occurs immediately after successful identification of the controlling transponder signal, the modification of the reader signal always occurring for a period shorter than the length of the controlling transponder signal.

Referring to claim 28 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 1.

Referring to claim 29 of (Application No. 10,635,683), corresponding to

(US# 6,661,336) claim 2.

Referring to claim 30 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 3.

Referring to claim 31 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 5.

Referring to claim 32 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 6.

Referring to claim 33 of (Application No. 10,635,683), the corresponding to (US# 6,661,336) claim 7, discloses a method of identifying a plurality of transponders comprising:

transmitting a reader signal from a reader, receiving the reader signal, in each transponder; and

recognizing in the reader a transponder signal transmitted from a transponder and immediately issuing a mute instruction from the reader, muting all other active transponders and passing control to the said transponder, without the need for a specifically timed acknowle.dgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is

maintained at the said pre-selected frequency. It is obvious the modulation of the reader signal includes at a pre-selected frequency in order to mute the transponders. However, (US# 6,661,336) claim 1 did not explicitly disclose the rf continuous wave reader signal at a pre-selected frequency. It is obvious implemented on a backscatter type as an alternative of transmitting the rf continuous wave reader signal at a pre-selected frequency. Furthermore, (US# 6,661,336) discloses issuing an acceptance instruction from the reader after the controlling transponder signal has been successfully received by the reader, the acceptance instruction being a modification of the reader signal, wherein the modification of the reader signal occurs immediately after successful identification of the controlling transponder signal, the modification of the reader signal always occurring for a period shorter than the length of the controlling transponder signal.

Referring to claim 34 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 7.

Referring to claim 35 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 8.

Referring to claim 36 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 9.

Referring to claim 37 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 11.

Referring to claim 38 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 12.

Referring to claim 39 of (Application No. 10,635,683), the corresponding to (US# 6,661,336) claim 13, discloses a transponder comprising:
receiver means for receiving a reader signal, transmission means for transmitting a transponder signal containing data whichidentifies the transponder, whereby in a set of transponders, two or more transponders may transmit their transponder response signals in response to receiving the reader signal; and control means whereby on recognizing a mute instruction in the reader signal all other active transponders in the set but one are muted and control is passed to said one transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency. It is obvious the modulation of the reader signal includes at a pre-selected frequency in order to mute the transponders. Furthermore, (US# 6,661,336) discloses the control means recognising an acceptance instruction from the reader after the controlling transponder signal has been successfully received by the reader, the acceptance instruction being a modification of the reader signal, wherein the modification of the reader signal occurs immediately after

successful identification of the controlling transponder signal, the modification of the reader signal always occurring for a period shorter than the length of the controlling transponder signal.

Referring to claim 40 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 13.

Referring to claim 41 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 14.

Referring to claim 42 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 15.

Referring to claim 43 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 17.

Referring to claim 44 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 18.

Referring to claim 45 of (Application No. 10,635,683), the corresponding to (US# 6,661,336) claim 19, discloses an integrated circuit for use in a transponder, comprising:

receiver means for receiving a reader signal at a pre-selected frequency, transmission means for transmitting a transponder signal containing data which identifies the transponder, whereby in a set of transponders, two or more transponders may transmit their transponder response signals in response to receiving the reader signal, and control means whereby on recognizing a mute instruction in the reader signal all other active transponders in the set but one are muted and control is passed to said one transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency. It is obvious the modulation of the reader signal includes at a pre-selected frequency in order to mute the transponders. Furthermore, (US# 6,661,336) discloses the control means recognising an acceptance instruction from the reader after the controlling transponder signal has been successfully received by the reader, the acceptance instruction being a modification of the reader signal, wherein the modification of the reader signal occurs immediately after successful identification of the controlling transponder signal, the modification of the reader signal always occurring for a period shorter than the length of the controlling transponder signal.

Referring to claim 46 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 19.

Referring to claim 47 of (Application No. 10,635,683), corresponding to

(US# 6,661,336) claim 20.

Referring to claim 48 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 21.

Referring to claim 49 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 23.

Referring to claim 50 of (Application No. 10,635,683), corresponding to (US# 6,661,336) claim 24.

Note: Examiner suggests filing a Terminal Disclaimer in order to place the following claims for allowance.

Referring to claim 27, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that "whereby upon recognising a transponder signal from a said transponder the reader immediately issues a mute instruction, muting all other active transponders and passing control to the said transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency".

Referring to claim 33, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that "recognizing in the reader a transponder signal transmitted from a transponder and immediately issuing a mute instruction from the reader, muting all other active transponders and passing control to the said transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency".

Referring to claim 39, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that "control means whereby on recognizing a mute instruction in the reader signal all other active transponders in the set but one are muted and control is passed to said one transponder, without the need for a specifically timed acknowledgement to the said controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency".

Referring to claim 39, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that control means whereby on recognizing a mute instruction in the reader signal all other active tranaponders in the set but one are muted and control is passed to said one transponder, without the need for a specifically timed acknowledgement to the said

controlling transponder, wherein the mute instruction comprises a modulation of the reader signal whilst the reader signal is maintained at the said pre-selected frequency".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Turner et al. (US# 2002/0024422) disclose the transponders immediately mute when received signal from the reader.

Caswell et al. (US# 5,231,273) disclose muting of the transponders.

Maletsky (US# 6,104,279) disclose setting the tag in quiet command.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications form the examiner should be directed to Scott Au whose telephone number is (571) 272-3063. The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (571) 272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Scott Au

MICHAEL HORABIK
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